

- Q<sup>2</sup>
17. (Amended) An apparatus as claimed in claim 14 wherein said bridge monitor is operable to monitor control signals on a primary Compact PCI bus in communication with the bridge and on a secondary Compact PCI bus in communication with the bridge.

### REMARKS

By the present amendment, no claims have been cancelled, claims 5 and 17 have been amended, and no new claims have been added. Accordingly, claims 1-25 are presently pending, and favorable reconsideration thereof is respectfully requested. Claims 1, 13 and 14 are the only independent claims.

Applicant wishes to thank the Examiner for her careful review of the present application and of the prior art.

#### 35 U.S.C. § 112

The Examiner has rejected claims 5, 17, 24 and 25 under 35 U.S.C. § 112, second paragraph, as being indefinite.

More particularly, in relation to claims 5 and 17, the Examiner has expressed the view that it is not clear what is meant by "DEVSEL#, C/BE#, STOP#, FRAME# and GNT# signals".

By the present amendment, Applicant has amended claims 5 and 17 to replace references to these specific types of Compact PCI Specification signals with a reference to "control signals". Applicant therefore respectfully submits that the rejection of claims 5 and 17 is overcome.

In relation to claims 24 and 25, the Examiner has expressed the view that the recitation "An inter-bus communication system" in the preamble of claim 24, and the recitation "A multiple bus system comprising the inter-bus communication system" in the preamble of claim 24, do not have clear antecedent basis.

Applicant respectfully submits that claims 24 and 25 comply with 35 U.S.C. § 112, second paragraph.

With respect to claim 24, Applicant agrees with the Examiner's observation that the phrase "An inter-bus communication system" does not have an antecedent basis earlier in the chain of dependence, however, an antecedent basis is not required, as this is the first occurrence in the claims of this phrase. Accordingly, as with the introduction of any term or phrase in a set of claims, the word "An" is used at the commencement of this phrase, to indicate that this is the first occurrence of the phrase in the chain of dependency of the claim. Applicant respectfully submits that one of ordinary skill in the art, to whom the patent specification is directed, would understand that claim 24 is directed to a system, the system comprising the apparatus of claim 14, and further comprising "a bridge ...". Applicant therefore respectfully submits that claim 24 complies with the requirements of 35 U.S.C. § 112, second paragraph. Applicant further respectfully submits that M.P.E.P. § 2173.05(f) implicitly contemplates claims of this "system" format as an acceptable type of claim, and respectfully observes that a significant number of US patents have issued containing such "system" claims (see for example claim 18 of US Patent No. 6,275,549 to Greatwood et al.; or claim 6 of U.S. Patent No. 6,230,753 to Jones et al.; numerous additional examples may be found in the USPTO database), evidencing the general approval of the USPTO of this format of claim. In view of the foregoing, Applicant respectfully submits that claim 24 complies with 35 U.S.C. § 112, and respectfully requests that the rejection of claim 24 be withdrawn.

Similarly, claim 25 is a system claim, directed to a multiple bus system comprising the inter-bus communication of claim 24, and further comprising "at least two data buses ...". Applicant therefore respectfully submits that claim 25 complies with 35 U.S.C. § 112, second paragraph, for reasons similar to those presented in connection with claim 24, and respectfully requests that the rejection of claim 25 be withdrawn.

35 U.S.C. § 102(e)

The Examiner has rejected claims 1, 2, 6, 9-12, 14-15 and 21-25 under 35 U.S.C. § 102(e) as being anticipated by Sherlock (US 6,304,936). The Examiner also appears to have rejected claim 13 on this ground.

The version of 35 U.S.C. § 102(e) applicable to the present application provides:

A person shall be entitled to a patent unless ...

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

Applicant respectfully submits that Sherlock is not citable under 35 U.S.C. § 102(e), as Applicant's invention date precedes the filing date of Sherlock.

In this regard, two Declarations pursuant to 37 C.F.R. § 1.131 are enclosed, showing an invention date preceding the U.S. filing date of Sherlock. In particular, the enclosed Declarations, executed by the named inventors of the present application, show a conception date at least as early as March 17, 1998, and an actual reduction to practice in Canada and the United States at least as early as April, 1998.

In contrast, Sherlock was filed in the United States on October 30, 1998. Therefore, Sherlock was not "filed in the United States before the invention thereof by the applicant", and is therefore not citable under 35 U.S.C. § 102(e).

Applicant therefore respectfully submits that the rejection of claims 1, 2, 6, 9-15 and 21-25 is overcome.

35 U.S.C. § 103 (a)

The Examiner has rejected claims 3, 4, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Sherlock in view of David et al. (U.S. 6,026,460). The Examiner has also rejected claims 8 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Sherlock in view of Duncan et al. (US 5,953,538). Finally, the Examiner has rejected claims 7, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Sherlock in view of Rozario et al. (US 6,173,378).

As noted above, the enclosed Declarations pursuant to 37 C.F.R. § 1.131 demonstrate an invention date preceding the U.S. filing date of Sherlock, and thereby demonstrate that Sherlock is not citable under 35 U.S.C. § 102(e). As Sherlock does not appear to be citable under any of the other sections of 35 U.S.C. § 102, it follows that Sherlock is not a citable reference under 35 U.S.C. § 103 (see e.g. M.P.E.P. § 2141.01).

Accordingly, as the primary reference cited against each of claims 3, 4, 7, 8, 16, 18, 19 and 20 is not a citable reference, Applicant respectfully submits that the rejections of these claims are overcome.

In view of the foregoing, Applicant respectfully submits that the application is now in condition for allowance, and respectfully requests that a Notice of Allowance be issued.

Applicant respectfully requests that the Notice of Allowance include a copy of the Form PTO-1449 submitted at the time of filing on December 2, 1999, bearing the Examiner's initials to confirm that the reference listed thereon has

been considered and will appear in the "References Cited" section of the patent when the present application issues.

Applicant has recently submitted, under separate cover, an Appointment of Associate Attorney or Agent, appointing the undersigned agent in connection with this application. The Appointment of Associate Attorney or Agent was executed by Mr. John W. Knox (Reg. No. 35,776), who was appointed by virtue of the Declaration and Power of Attorney as originally filed. Applicant has received a date stamped return postcard confirming that the United States Patent and Trademark Office mailroom received the Appointment document on April 25, 2002.

Applicant hereby petitions for an automatic one-month extension of time, from May 28, 2002 to June 28, 2002, for responding to the Office Action dated February 28, 2002. A check in the amount of \$110.00 is attached as payment of the extension fee pursuant to 37 C.F.R. § 1.17(a)(1). The Commissioner is authorized to charge any further fees that may be required, or to credit any overpayment, to Deposit Account Number 06-0713.

Respectfully submitted,



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JWK:SJF:cmm:djo

Encl.: Version with Markings Showing Changes  
Signed Declaration Pursuant to 37 C.F.R. § 1.131 of Norbert Wegner  
Signed Declaration Pursuant to 37 C.F.R. § 1.131 of Peter Arkadjevich Bliznyuk-Kvitko  
Petition Pursuant to 37 C.F.R. § 1.91  
Bank Draft for \$130.00 (Petition Fee)  
Bank Draft for \$110.00 (Extension of Time Fee)  
Acknowledgement Card

**VERSION WITH MARKINGS SHOWINGS CHANGES MADE**

In the Claims:

Claim 5 has been amended as follows:

5. (Amended) A method as claimed in claim 4 wherein monitoring includes monitoring ~~DEVSEL#, C/BE#, TRDY#, STOP#, FRAME# and GNT#~~ control signals on a primary Compact PCI bus and ~~monitoring C/BE#, FRAME# and GNT# signals~~ on a secondary Compact PCI bus.

Claim 17 has been amended as follows:

17. (Amended) An apparatus as claimed in claim 14 wherein said bridge monitor is operable to monitor ~~DEVSEL#, C/BE#, TRDY#, STOP#, FRAME# and GNT#~~ control signals on a primary Compact PCI bus in communication with the bridge and ~~C/BE#, FRAME# and GNT# signals~~ on a secondary Compact PCI bus in communication with the bridge.